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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,666	10/18/2004	Milton L. Brown	00769-07	4259

34444 7590 08/10/2007
UNIVERSITY OF VIRGINIA PATENT FOUNDATION
250 WEST MAIN STREET, SUITE 300
CHARLOTTESVILLE, VA 22902

EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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08/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,666	BROWN, MILTON L.	
	Examiner	Art Unit	
	Taylor Victor Oh	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-15,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/05 & 03/06</u> | 6) <input type="checkbox"/> Other: _____ |

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The Status of Claims:

Claims 1-20 are pending.

Claims 1-2, 4-15 and 19-20 are rejected.

Claims 3, and 16-18 have been withdrawn from consideration.

Election/Restrictions

Applicant's election without traverse of Group I, namely Claims 1-2, 4-15 and 19-20 on 7/23/07 is acknowledged.

Claims 3, and 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Groups II and III, there being no allowable generic or linking claim.

DETAILED ACTION

1. Claims 1-2, 4-15 and 19-20 are under consideration in this Office Action.

Priority

2. It is noted that this application is a 371 of PCT/US03/12162 (04/18/2003) which claims benefit of 60/373,440 (04/18/2002) and claims benefit of 60/373,784 (04/19/2002).

Drawings

3. The drawings filed on 10/18/04 are accepted by the Examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-15 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 19, the term "substituted" is recited. This is indefinite. In the absence of the specific moieties intended to effectuate modification by the "substitution" or attachment to the chemical core claimed, the term "substituted" renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed. Therefore, an appropriate correction is required.

In claims 1, 10, 14, and 19, the term "general" is recited. This is vague and indefinite because the specification does not elaborate what is meant by the term "general"; for example, how general the formula or structure is. Therefore, an appropriate correction is required.

Claim Rejections - 35 USC § 102

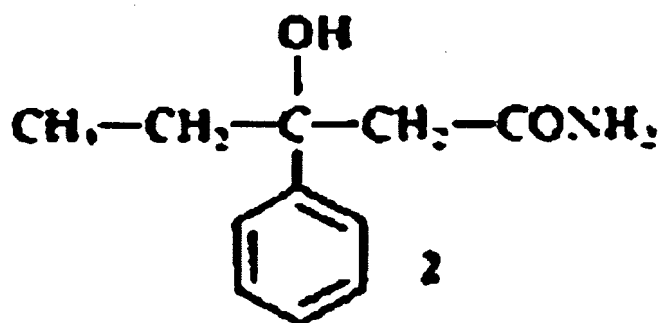
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-2, 4-5, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Meza-Toledo, S.E. et al (Drug Research , vol. 40, p. 1289-1291).

Meza-Toledo, S.E. et al discloses the following compound (see page 1290, section 3.2, compound 2) :

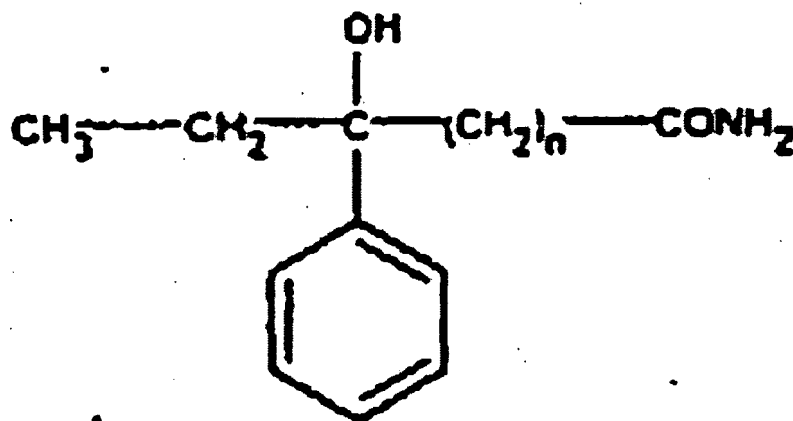


This is identical with the claims.

2. Claims 1-2, 4-5, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Meza-Toledo, S.E. et al (Drug Research , vol. 45, p. 756-759).

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Meza-Toledo, S.E. et al discloses the following compound (see page 756, left col. at the bottom) :



<u>n</u>	<u>Compound</u>
0	DL-HEPA ^a
1	DL-HEPP ^b
2	DL-HEPB ^c

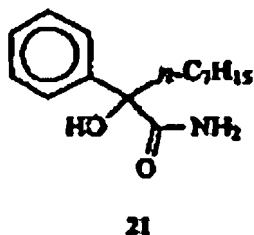
This

is identical with the claims.

3. Claims 1-2, 4-5, 10, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Brown et al (J. Med. Chem.. 1999, 42, p. 1537-45).

Brown et al discloses the following compound. (see page 1539, a middle table 4)

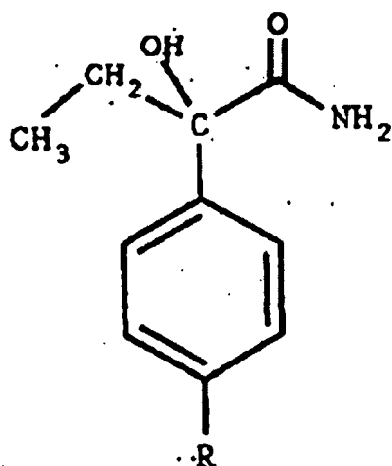
Table 4. Predicted and Actual Sodium Channel Binding Activities for Diverse Analogues Forming the Test Set



This is identical with the claims.

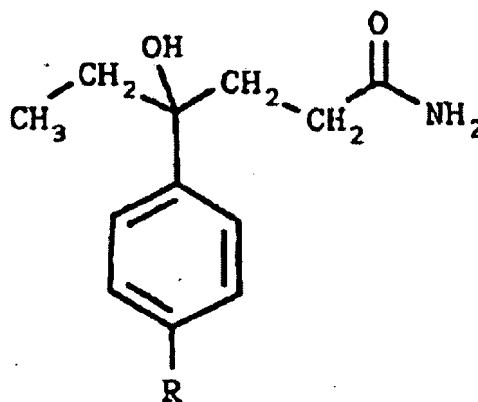
4. Claims 1-2, 4-6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Sandoval et al (WO 99/41229).

Sandoval et al discloses the following compound (see fig. 1 and 4) :



R= F DL-F-HEPA

R= Cl DL-Cl-HEPA



R= F DL-F-HEPB

R= Cl DL-Cl-HEPB

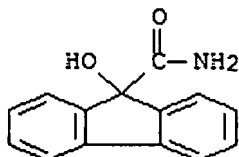
This is identical with the claims.

5. Claims 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Grunewald et al (Tetrahedron Letters, 1980, 21(13), p.1219-1220).

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Grunewald et al disclose the following abstract and compound:

AB Hydrolysis of the trimethylsilyl ethers of cyanohydrins of aryl alkyl and diaryl ketones with HCl or HNO₃/HCO₂H gave the corresponding .alpha.-hydroxy amides. E.g., PhCOEt reacted sequentially with Me₃SiCN in the presence of ZnI₂ and HCl giving 75-90% PhC(OH)EtCONH₂. Similar reaction was obsd. for 9-fluorenone.



This is identical with the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TAYLOR VICTOR OH
PRIMARY EXAMINER

8/3/57